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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,681	04/02/2004	Richard A. Wilson JR.	100-2134	9747

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Canon U.S.A. Inc.
Intellectual Property Department
15975 Alton Parkway
Irvine, CA 92618

EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/816,681

Applicant(s)

WILSON ET AL.

Examiner

Nicholas D. Rosen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-24 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 3, 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al. (U.S. Patent Application Publication 2005/0102362) in view of Harper (U.S. Patent Application Publication 2002/0143642). As per claim 1, Price discloses a method for using real-time communication to obtain products or services. Price discloses a real-time chat (aka Instant Messaging) application, which implies launching and logging in to the chat application, and making possible the

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discovery of any messages from peripheral devices: Price discloses displaying messages from peripheral devices connected to the client device; and displaying products and/or services for the peripheral device (Abstract; paragraphs 18-20, and 25). Price does not disclose selecting a peripheral device from the detected peripheral devices, but the display of messages implies some type of selection (the client device must select messages to display, which implies selecting a message from a particular peripheral, even if the user does not necessarily select a particular peripheral to display messages from). Price does not expressly disclose obtaining products and/or services for the selected peripheral device, although presumably the "appropriate party" would respond to "an appropriate Instant Messaging message" by obtaining products and/or services, e.g., obtaining more paper from the appropriate drawer for a printer which sends an out-of-paper message, but Harper teaches obtaining such products and/or services (e.g., Abstract; paragraphs 33 and 34). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to obtain such products and/or services, for the obvious advantage of restoring the peripheral device to functioning.

As per claim 2, Harper teaches that the products and/or services displayed for the selected peripheral device are provided to the client device by a remote server (e.g., Abstract; paragraphs 33 and 34). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the products and/or services to be provided to the client device by a remote server, for the stated advantage of readily enabling automated remote ordering.

As per claim 3, Harper teaches that the products include consumables for the selected peripheral device (Abstract; paragraphs 23 and 24). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the products to include consumables, for the obvious advantage of providing the peripheral device with the consumables (e.g., paper or toner for printer) that it requires to perform its functions.

As per claim 5, Price discloses the real-time chat application obtaining status information from the peripheral devices (Abstract; paragraphs 18-20, and 25).

As per claim 6, Harper teaches transmitting obtained status information, and/or ordering information based thereon, to a remote server (paragraphs 23-25). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do so, for the stated advantage of purchasing consumables from a desired reseller using appropriate information.

As per claim 8, Harper teaches automatically obtaining products or service based on the status information (paragraph 34). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to automatically obtain products or services, for the obvious and implied advantage of saving the user the trouble of confirming routine orders.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Price and Harper as applied to claim 1 above, and further in view of Meade, II et al. (U.S. Patent Application Publication 2002/0140966). Neither Price nor Harper discloses that the services include updates for software on the client device, but Meade teaches this (e.g.,

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Abstract). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the services to include updates for software, for the stated or implied advantages of encouraging users to update software, and enabling them to control such updates (paragraphs 4 and 5 of Meade).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Price and Harper as applied to claim 6 above, and further in view of Hayward et al. (U.S. Patent 6,629,134). Price does not disclose that real-time notifications are based on the obtained status information, but Hayward teaches a remote server providing additional information, which can be considered notifications, based on status information (Abstract; column 2, lines 20-40; column 6, line 42, through column 7, line 9; column 7, lines 49-66). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for a remote server to generate and provide notifications, for the stated advantage of helping users replace parts, buy consumables, or make other repairs.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price and Harper as applied to claim 1 above, and further in view of DeMaria ("Rendezvous of the LAN Side"). As per claim 9, Price discloses peripheral devices connected to the client device via a network (Figure 1; paragraphs 28, 34, 36, etc.). DeMaria teaches a protocol for enabling computers to discover printers and other network entities with no user intervention needed (first paragraph; also note "A printer could even broadcast" in the second paragraph). Hence, it would have been obvious to

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one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the discover operation to comprise detecting peripheral devices connected to the client device via a network, for the obvious advantage of enabling appropriate communication with the peripheral devices, so as to arrange for repairs, obtaining consumables, etc.

As per claim 10, selecting a peripheral device is implied, as set forth above in the rejection of claim 1.

As per claim 11, Price implies that products and/or services are obtained for the peripheral device, and Harper is explicit, as set forth above in the rejection of claim 1.

As per claim 12, Price discloses that the selected peripheral can be managed remotely (paragraph 25).

Claims 13, 14, 15, 17, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price (U.S. Patent Application Publication 2005/0102362) in view of Harper (U.S. Patent Application Publication 2002/0143642). Claim 16 is rejected over Price and Harper, and further in view of Meade, II et al. (U.S. Patent Application Publication 2002/0140966). Claim 19 is rejected over Price and Harper, and further in view of Hayward et al. (U.S. Patent 6,629,134). Claims 21-24 are rejected over Price and Harper, and further in view of DeMaria ("Rendezvous of the LAN Side").

Claims 13-24 are closely parallel to claims 1-12, respectively, and rejected on the same grounds set forth above.

It is noted that claims 13-24 use "means for" language. Nonetheless, they are not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35

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U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Response to Arguments

Applicant's arguments filed October 6, 2006, have been fully considered but they are not persuasive. Applicant argues that nothing in Price, the primary reference is seen to describe initiating a discovery operation on a client device upon logging into a real-time chat application, displaying peripheral devices detected by the discovery operation, selecting a peripheral device from the detected peripheral devices, displaying products and/or services for the selected peripheral device, and obtaining products and/or services for the selected peripheral device. Noting that Examiner's Office action asserts that Price's disclosure of a chat application receiving messages from peripheral devices implies launching and logging in to the chat application, and making possible the discovery of any messages from peripheral devices, Applicant argues that the Office Action provides no support for the assertion. Applicant writes that real-time chat applications send and receive chat messages, much like electronic mail messages sent to particular electronic mail addresses. Examiner accepts the analogy, and replies that to receive electronic mail messages, one either opens an e-mail application and downloads accumulated e-mail messages (e.g., from an ISP, upon logging on), or, after

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opening an e-mail application, receives additional e-mail messages as they are sent, and likewise with chat. Having an open chat application is taken as implying that the application has been launched, and that a discovery operation is performed to discover messages.

Secondly, Applicant argues that discovery of messages is not the same as device discovery, and describes device discovery as the discovery of the existence of a device. Examiner replies that this is a limitation not clearly set forth in the claims. Claim 1 recites "initiat[ing] a discovery operation on the client device," without specifying what is discovered. The next element, "displaying peripheral devices connected to the client device detected by the discovery operation," is more suggestive, but does not recite a specific of discovering the existence of devices; it can be read as implying only that there is a display of peripheral devices detected as having sent chat messages to the client device.

Observing that the Office Action concedes that Price does not disclose selecting a peripheral device from the detected peripherals, Applicant disputes Examiner's statement that selection is implied. Examiner reiterates that selecting a message from a particular peripheral is implied. If, as in paragraph 20 of Price), a message is sent that a particular printer is jammed or out of paper, or that a fax has been delivered, display of the message is held to constitute selection, by the client device, of the printer, fax machine, or similar peripheral to display a message from.

While Price does not disclose obtaining products and/or services for the selected peripheral devices, Harper is held to make this element obvious (Abstract; paragraphs

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33 and 34). Applicant lists various elements of how, in Applicant's claimed invention, "a user is presented products and services pertaining to the peripheral device" (bottom paragraph on pages 6 of the Remarks/Arguments). Examiner replies that, aside from the question of whether these features would be found non-obvious if they were searched, they are not claim limitations, and therefore cannot make the claims patentable.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith, can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER

December 4, 2006